

Docket No.: KAK-0001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiroshi Mikitani et al.

Application No.: 09/653,163

Confirmation No.: 5466

Filed: September 1, 2000

Art Unit: 3628

For: LOTTERY SYSTEM UTILIZING
ELECTRONIC MAIL

Examiner: I. N. BORISSOV

APPEAL BRIEF

MS Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This is an Appeal Brief under 37 C.F.R. §41.37 appealing the final decision of the Examiner dated January 29, 2008. Each of the topics required by 37 C.F.R. §41.37 is presented herewith and is labeled appropriately. This brief is in furtherance of the Final Office Action on January 29, 2008.

A Notice of Appeal was filed in this case on April 9, 2008, along with a Request for Panel Review.

The Notice of Panel Decision from Pre-Appeal Brief Review mailed on May 7, 2008. (“the Decision”) indicates that claims 1-4, 6, 8-13 and 16-26 remain rejected. The Decision further indicates that the extendable time period for the filing of the Appellant’s Brief will be reset to be

one month from the mailing of the Decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater.

Because two-month time period running from the filing date of the Notice of Appeal ends on June 9, 2008, the filing of the Appellant's Brief is timely. 37 C.F.R. §1.136.

I. REAL PARTY IN INTEREST

Rakuten Inc. of Tokyo, Japan ("Rakuten") is the real party in interest of the present application. Assignments of all rights in the present application to Rakuten were executed by the inventors and recorded by the U.S. Patent and Trademark Office at **Reel 11342, Frame 0522**.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Within the Final Office Action of July 2, 2007:

Page 2 of the Final Office Action indicates a rejection of claims 1-4, 6, 8-13 and 16-22 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589 to Strandberg in view of US Patent No. 5,983,196 to Wendkos.

Page 8 of the Final Office Action indicates a rejection of claims 8 and 9 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589 to Strandberg in view of US Patent No. 5,983,196 to Wendkos and further in view of US Patent No. 6,024,641 to Sarmo.

Page 9 of the Final Office Action indicate a rejection of claim 23-26 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0161589

to Strandberg in view of US Patent No. 5,983,196 to Wendkos and further in view of US Patent No. 6,193,605 to Libby et al.

Thus, the status of the claims is as follows:

Claim 1-4 (Rejected)

Claim 5 (Canceled)

Claim 6 (Rejected)

Claim 7 (Canceled)

Claim 8-13 (Rejected)

Claim 14-15 (Canceled)

Claim 16-26 (Rejected)

No claims are indicated within the Final Office Action to contain allowable subject matter.

The claims on appeals are claims 1-4, 6, 8-13 and 16-26 which are presented in the Claims Appendix.

IV. STATUS OF AMENDMENTS

Provided is a statement of the status of any amendment filed subsequent to final rejection.

No amendment has been filed after Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following description is provided for illustrative purposes and is not intended to limit the scope of the invention.

Claims 1-4, 6, 8, 9, 12, and 13

Claims 1-4, 6, 8, 9, 12, and 13 stand or fall together. Claims 2-4, 6, 8, 9, 12, and 13 are dependent on claim 1.

One of the aspects of the claimed subject matter relates to a lottery system utilizing an electronic mail, and the system generates a return e-mail address, fixes it to an e-mail and sends the e-mail to limited participants. The limited participants reply to the return e-mail address so that the system can recognize the participants for a lottery from the returned e-mail (the returned e-mail address).

Claim 1 is drawn to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising:

storing means for storing information of customers (page 10 lines 17-24; FIG. 4);

means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

means for uniquely allocating a reply electronic mail address to each of said specified participants, so that said reply electronic mail addresses are different from each other (page 6, lines 11-18);

means for sending a first electronic mail to each of said participants, in which the reply electronic mail address is affixed as a unique access key to each of said participants (page 6, lines 19-21; FIG. 4);

means for recognizing an application for the lottery from each of said participants by receiving a second electronic mail sent back to said reply electronic mail address (page 6, line 23 to page 7, line 27); and

means for notifying each one of said participants who sent back the second electronic mail to the reply electronic mail address of the result of said lottery (page 8, lines 13 to 30; FIG. 4).

Claim 8

Claim 8 depends on claim 6 which depends on claim 1. One of the aspects of he claimed subject matter relates to a lottery system utilizing an electronic mail, wherein the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize.

Claim 8 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B) according to claim 6, wherein the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize (page 9 line 21 to page 10 line 15; FIG. 4).

Claim 9

Claim 9 depends on claim 6 which depends on claim 1. Another aspect of the claimed subject matter relates to a lottery system utilizing an electronic mail, wherein by entering said access keyword and a destination electronic mail address to which the third electronic mail is sent, into the page informing of said result, the page for the win of the prize or the page of the failure in winning the prize can be accessed.

Claim 9 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B) wherein by entering said access keyword and a destination electronic mail address to which the third electronic mail is sent, into the page informing of said result, the page for the win of the prize or the page of the failure in winning the prize can be accessed (page 9, lines 6-12; FIG. 4).

Claims 10, 11 and 18

Claims 10, 11 and 18 stand or fall together. Claims 11 and 18 is dependent on claim 10.

Claim 10 is drawn to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising:

storing means for storing information of customers (page 10 lines 17-24; FIG. 4);

means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

means for uniquely allocating a keyword to be entered in a page of a URL, to each of the participants so that the keywords are different from each other (page 13, lines 14-32; FIG. 6);

means for sending an electronic mail in which the keyword is affixed as a unique access key, to each of the participants (page 14, lines 1-10; FIG. 6);

means for recognizing an application from each of said participants when said participant accesses the page of said URL and enters the keyword (page 14, line 12 to page 15, line 2; FIG. 6); and

means for notifying each of said participants of the result of the lottery (page 15, lines 4-18; FIG. 6).

Claim 16

Claim 16 is drawn to a method for conducting a lottery (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising the steps of:

storing information of customers in a database (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B);

limiting the customers stored in the database in advance so as to specify particular participants for a lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

allocating uniquely a reply electronic mail address to each of said specified participants so that the reply electronic mail addresses are different from each other (page 6, lines 11-18);

sending by a host a first electronic mail in which the reply electronic mail address is affixed as a unique access key to each one of a plurality of said specified participants (page 6, lines 19-21; FIG. 4);

recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said reply electronic mail address from each of said participants (page 6, line 23 to page 7, line 27);

conducting said lottery (page 7, line 28 to page 8, line 11; FIG. 4); and

notifying each one of the participants who sent back the second electronic mail of their result of said lottery (page 8, lines 13 to 30; FIG. 4).

Claim 17

Claim 17 is drawn to lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising:

storing means for storing information of customers (page 10 lines 17-24; FIG. 4);

means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

means for uniquely allocating a URL to each of said participants so that the URLs are different from each other (page 13, lines 14 to page 14 line 5; FIG. 6);

means for sending an electronic mail in which the URL is affixed as a unique access key to each of the participants (page 14, lines 1-10; FIG. 6);

means for recognizing an application from each of the participants when the participant accesses a page of the URL and enters an electronic mail address of the participant (page 14, line 12 to page 15, line 2; FIG. 6); and

means for notifying each of said participants of the result of said lottery (page 15, lines 4-18; FIG. 6).

Claim 19

Claim 19 is drawn to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising:

storing means for storing information of customers (page 10 lines 17-24; FIG. 4);

means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

means for providing at least one electronic mail address (page 6, lines 11-18);

means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other (page 6, lines 11-18);

means for sending by a host a first electronic mail to each one of the specified participants, wherein the uniquely allocated at least one electronic mail address is affixed to the first electronic mail (page 6, lines 19-21; FIG. 4);

means for receiving a second electronic mail sent from each one of the specified participants to the uniquely allocated at least one electronic mail address, so as to recognize the participants (page 6, line 23 to page 7, line 27);

means for conducting the lottery (page 7, line 28 to page 8, line 11; FIG. 4); and

means for notifying each one of the recognized participants who sent the second electronic mail, of a result of the lottery (page 8, lines 13 to 30; FIG. 4).

Claim 20

Claim 20 is drawn to a method for conducting a lottery (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), comprising the steps of:

storing information of customers in a database (page 10 lines 17-24; FIG. 4);

limiting the customers stored in the database in advance so as to specify particular participants for the lottery (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

providing at least one electronic mail address (page 6, lines 11-18);

allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other (page 6, lines 11-18);

sending by a host a first electronic mail to each one of the specified participants, wherein the uniquely allocated at least one electronic mail address is affixed to the first electronic mail (page 6, lines 19-21; FIG. 4);

receiving a second electronic mail sent from each one of the specified participants to the uniquely allocated at least one electronic mail address, so as to recognize the participants (page 6, line 23 to page 7, line 27);

conducting the lottery (page 7, line 28 to page 8, line 11; FIG. 4); and

notifying each one of the recognized participants who sent the second electronic mail, of a result of the lottery (page 8, lines 13 to 30; FIG. 4).

Claims 21-22

Claims 21-22 stand or fall together. Claim 22 depend on claim 21.

Claim 21 is drawn to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B) comprising:

- recording means for recording information concerning customers, each of which has an electronic mail address (page 10 lines 17-24; FIG. 4);

- means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers (page 5, lines 15-28 and page 6, lines 5-11; FIGS. 3A, 3B and 4);

- means for issuing a unique access key to be affixed to said electronic mail address of each of said participants of said main group (page 6, lines 5-18);

- means for assigning said unique access key to said electronic mail address to generate a reply electronic mail address for the lottery after specifying said main group for the lottery (page 6, lines 5-18);

- means for recording said unique access key in association with said electronic mail address of each of said participants of said main group (page 6, lines 5-18);

- means for sending by a host a first electronic mail to said reply electronic mail address of each of said participants of said main group, in which said unique access key is affixed to said reply electronic mail address of each of said participants of said main group (page 6, lines 19-21; FIG. 4);

- means for recognizing an application for the lottery from each of said participants by receiving a second electronic mail sent back to said reply electronic mail address (page 6, line 23 to page 7, line 27);

- means for distinguishing said access key with reference to said means for recording said unique access key (page 7, lines 4-27);

- means for conducting the lottery (page 7, line 28 to page 8, line 11; FIG. 4); and

- means for notifying each one of said participants who sent back said second electronic mail to said reply electronic mail address, of the result of said lottery (page 8, lines 13 to 30; FIG. 4).

Claim 23

Claim 23 depends on claim 21. An aspect of the claimed subject matter relates to a lottery system utilizing an electronic mail,

Claim 23 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), wherein said drawing is performed on the basis of the number of said participants of said main group (page 15, lines 4-12, FIG. 6).

Claim 24

Claim 24 depends on claim 21. An aspect of the claimed subject matter relates to a lottery system utilizing an electronic mail,

Claim 24 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), wherein said means for conducting the lottery generates random number on the basis of the number of said participants of said main group, thereby obtaining the result of said lottery (page 15, lines 4-12, FIG. 6).

Claim 25

Claim 25 depends on claim 21. An aspect of the claimed subject matter relates to a lottery system utilizing an electronic mail,

Claim 25 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B), wherein said lottery system further comprising means for recording a result of the lottery (page 9, line 3-5, page 10, line 16-24); wherein the result of said lottery is previously decided on the basis of the number of said participants of said main group before sending said electronic mail (page 6, 28-30), and wherein said means for conducting the lottery includes means for confirming said unique access key with reference to said means for recording the result of the lottery when receiving said second electronic mail (page 9, line 6-19, FIG. 4).

Claim 26

Claim 26 depends on claim 21. An aspect of the claimed subject matter relates to a lottery system utilizing an electronic mail,

Claim 26 is directed to a lottery system utilizing an electronic mail (page 4, line 32 to page 5, line 14; FIGS. 3A and 3B) wherein said means for conducting the lottery generates random number on the basis of the number of said participants of said main group, thereby deciding the result of the lottery (page 7, line 28 to page 8, line 6).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-4, 6, 8-13 and 16-22

Claims 1-4, 6, 8-13 and 16-22 have been rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196). Applicants respectfully traverse this rejection.

2. Claims 8 and 9

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196) and further in view of Sarno (US 6,024,641). Applicants respectfully traverse this rejection.

3. Claims 23-26

Claims 23-26 are rejected under 35 U.S.C. §103(a) as unpatentable over Strandberg (US 2002/0161589) in view of Wendkos (US 5,983,196) and further in view of Libby et al. (US 6,193,605). Applicants respectfully traverse this rejection.

VII. ARGUMENT

In the Final Office Action of January 29, 2008:

The Examiner erred in rejecting claims 1-4, 6, 8-13 and 16-22 under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos.

The Examiner erred in rejecting claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos and further in view of Sarno.

For at least the following reasons, Appellants submit that this rejection is legally unsound and should therefore be reversed.

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below.

1. Claims 1-4, 6, 8-13 and 16-22 have been erroneously rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos.

(a) Claims 1-4, 6, 8, 9, 12 and 13

The Office Action asserts that Wendkos teaches that ... said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner), citing C. 10, L. 56-67; C. 11, L. 15-C. 12 L. 8).

(1) Examiner's error in determining that Wendkos teaches means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery [0019].

Wendkos fails to teach "means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery." That is, in claim 1, customers are limited to a certain number of customers, and then a lottery is performed for only the limited customers. On the other hand, Wendkos does not limit the customer before the lottery is performed. That is, in Wendkos, the award selection is executed for participants but participant selection is not performed. That is, the award selection algorithm of Wendkos is executed in order to determine who is awarded, but not who are participants of the lottery.

As to this point, the Final Office Action asserts that “Wendkos teaches a method and system for conducting a lottery via the Internet, wherein participants are notified (are send (sic) messages to) of their result in said lottery, and wherein said system includes means for limiting the customers so as to specify a main group for performing the lottery (The function of the **smart win process** is to make awards to certain participant in a controlled manner) (C.10, L.56-67; C. 11, L.15-C.12 L.8). Further, the Office Action asserts that **Wendkos explicitly teaches identifying a specific group of customers** eligible for the lottery from the database of all customers, thereby disclosing the ”advance” feature (C.10, L.35-53).

(i) Smart Win Process

The “smart win process” that Examiner points out is not a process of limiting participants from whom winners are selected, but a process of selecting award winners. Thus, description of the “smart win process” has nothing to do with “means for limiting the customers so as to specify a main group for performing the lottery.” (Emphasis added)

(ii) Examiner’s error in determining that Wendkos explicitly teaches identifying a specific group of customers

Wendkos discloses at C.10, L. 35-53 as follows:

A particularly powerful use of this capability is found under the circumstance when a sponsor of a promotional program wishes to identify his "good customers." A good customer might be defined as a customer who has made three purchases of a particular type in the last thirty days. By invoking the name and address capture routine of FIGS. 11A and 11B, only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and addresses which contain only those customers who have made such purchases. In the prior art, a

sponsor of a program was limited to either capturing everyone's name and address, or no one's. **This permits the name and address capture to be customized to the needs of the particular sponsor. As a result, since the cost of direct mailings is very high, the sponsor can customize a mailing to only his best purchasers,** however the sponsor may define that term. As a result, a sponsor will not waste resources in conducting a direct mailing to customers who might not be responsive to his entreaties. (Emphasis added).

Thus, the Examiner errs in determining that Wendkos teaches said system includes means for limiting the customers so as to specify a main group for performing the lottery. That is, Wendkos discloses that “[a] particularly powerful use of this capability is found when a sponsor of a promotional program wishes to identify his good customers” and “only for those participants who have registered certificates for the three purchases in question within thirty days, the sponsor of the program can receive a list of names and address which contain only those customers who have made such purchases.”

However, although Wendkos teaches that customer information may be used for selection of customer for **direct mailings**, it does **NOT** teach that participants are selected from the customer information. Thus, Wendkos fails to disclose, teach or suggest “means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery” as recited in claim 1.

At page 9 of the Final Office Action, Examiner states that “In response to applicant’s argument that the prior art fails to disclose means for limiting the customers (stored in the database) in advance, it is noted that Wendkos explicitly teaches said feature. Specifically, Wendkos teaches that a specific group of customers can be identified (for conducting a lottery) based on certain criteria (C. 10, L. 35-53). The motivation of doing so would be not wasting resources for not promising customers (see a discussion above).

However, in the paragraph of Wendkos the Examiner indicates (C. 10, L. 35-53), there is no description of conducting an incentive awards program (or lottery) for the limited customers.

Wendkos merely teaches that such information of good customers is used for **direct mailings**. Thus, in Wendkos, good customer information is not used for the incentive awards program or a lottery. Applicant has no idea on how Examiner reaches the conclusion that Wendkos explicitly teaches said feature. Accordingly, since the Examiner does not show that the information of good customers (limited customers) is used for selection of participants of an incentive awards program (or lottery), the concept of limiting participants may not be combined the incentive awards program of Wendkos. The Examiner's rejection is based on his hindsight.

(2) Examiner's error in determining that Strandberg teaches a ... system..., comprising:... allocating uniquely an electronic mail address to each of participants [0018], [0019].

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."

(i) E-mail address allocated by the system

In Strandberg, e-mail address in the database 200 is supplied by the customers, but not created (allocated) by the system of Strandberg. Thus, Examiner fails to establish a *prima facie* case of obviousness.

(ii) Reply E-mail Address

Examiner ignores the limitation "reply" in claim 1. Because of the ignorance, the Office Action fails to show all the limitation within the applied art.

That is, Strandberg fails to teach means for uniquely allocating a reply electronic mail address although Strandberg teaches electronic mail address supplied by the customer. Thus, Examiner fails to establish a *prima facie* case of obviousness.

Moreover, in the paragraphs [0018] and [0019], Strandberg teaches “a unique ID to link to an interested party database record”. However, it does not disclose, teach or suggest “means for uniquely allocating a reply electronic mail address to each of said specified participants, so that said reply electronic mail addresses are different from each other.” Strandberg does not describe the “ID” as an e-mail address.

Specifically, in the paragraphs [0023] of Strandberg, it is disclosed that “[t]he mail to method includes the call center e-mail address along with the unique ID.” “[T]he call center e-mail address” is not uniquely allocated e-mail address to each of participants since in the phrase, an article “the” precedes the phrase “call center e-mail address” so that the mail includes only the e-mail address common to all of them.

Thus, none of the applied art, alone or in combination, does not disclose, teach or suggest “means for uniquely allocating a reply electronic mail address to each of said specified participants, so that said reply electronic mail addresses are different from each other”. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(b) Claims 10, 11 and 18

(1) Examiner’s error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing the lottery... (C. 10, L56-67).

As discussed above, Wendkos fails to disclose, teach or suggest “means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner’s error in determining that Strandberg teaches means for uniquely allocating a keyword to be entered in a page of a URL, to each of participants [0018], [0019].

Strandberg teaches that “[t]his e-mail message may contain information such as the information requested by the interested party, information concerning an account delinquency, a request for the interested part to call a particular telephone number and/or a Uniform Resource

Locator (URL) address of a particular Internet –World Wide Web address, including a unique ID to link to an interested party database record.”

However, Strandberg fails to teach **a keyword to be entered in a page of a URL** although it teaches a unique ID to link to an interested party database record. In Strandberg, the unique ID is not described as the “keyword to be entered in a page of a URL. There is no explanation on how the unique ID suggests the “keyword to be entered in a page of a URL.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(c) Claim 16

(1) Examiner’s error in determining that Wendkos teaches “limiting the customers so as to main group for performing the lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C10, L56-67; C. 11, L15-C12, L. 8).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest “limiting the customers stored in the database in advance so as to specify particular participants for a lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner’s error in determining that Strandberg teaches a method ... comprising: allocating uniquely an electronic mail address to each of participants [0018], [0019].

Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.”

As discussed above with respect to claim 1, none of the applied art, alone or in combination, does not disclose, teach or suggest “allocating uniquely a reply electronic mail address to each of

said specified participants so that the reply electronic mail addresses are different from each other.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(d) Claim 17

(1) Examiner’s error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing a lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C11, L. 15-C. 12, L 8).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest “means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner’s error in determining that Strandberg teaches means for uniquely allocating a URL to each of said participants so that the URLs are different from each other [0018],[0019].

Strandberg teaches that “[t]his e-mail message may contain information such as the information requested by the interested party, information concerning an account delinquency, a request for the interested part to call a particular telephone number and/or a Uniform Resource Locator (URL) address of a particular Internet –World Wide Web address, including a unique ID to link to an interested party database record.”

However, although Strandberg teaches that e-mail message may contain information such as URL address of a particular Internet, it does not teach “the URLs are different from each other”. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(e) Claim 19

(1) Examiner’s error in determining that Wendkos teaches means for limiting the customers so as to specify a main group for performing a lottery (The function of the smart win process is to make awards to certain participant in a controlled manner) (C. 10, L. 56-67; C. 11, L. 15-C. 12, L8).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest “means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner’s error in determining that Strandberg teaches means for providing at least one electronic mail address [0018] and means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other [0018], [0019].

Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.”

As discussed above, in Strandberg, the e-mail address in the database 200 is supplied by the customers, but not created (allocated) by the system of Strandberg. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(f) Claim 20

(1) Examiner's error in determining that Wendkos teaches limiting the customers so as to specify a main group for performing the lottery (The function of the smart win program is to make awards to certain participant in a controlled manner) (C. 10, L 56-67; C. 11, L. 15-C. 12, L. 8).

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "limiting the customers stored in the database in advance so as to specify particular participants for the lottery." Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner's error in determining that Strandberg teaches means for providing at least one electronic mail address and means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other [0018], [0019].

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."

As discussed above, in Strandberg, the e-mail address in the database 200 is supplied by the customers, but not created (allocated) by the system of Strandberg. Thus, Examiner fails to establish

a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(g) Claims 21 and 22

(1) Examiner's error in determining that Wendkos teaches means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers [0019].

As discussed above, in the paragraphs that the Examiner indicates, good customer information used for direct mailings and an award algorithm (smart win process) that selects award winners, is described, but there is no description of limiting the customers stored in the database in advance so as to specify particular participants for a lottery. Thus, Wendkos fails to disclose, teach or suggest "means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers." Thus, Examiner fails to establish a *prima facie* case of obviousness.

(2) Examiner's error in determining that Strandberg teaches means for assigning said unique access key to said electronic mail address to generate a reply electronic mail address for the lottery after specifying said main group for the lottery [0018], [0019].

Strandberg teaches that "the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address."

However, the Examiner ignores the limitation of "reply", and further, in Strandberg, the e-mail address in the database 200 is supplied by the customers but not created (allocated) by the system of Strandberg. Strandberg fails to teach generation of a reply electronic mail address by assigning said unique access key to said electronic mail address. Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

2. Claims 8 and 9 have been erroneously rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos and further in view of Sarno.

(a) Claim 8

Claim 8 depends on claim 6 which depends on claim 1, and as discussed in the section 1.(a)(1) as to claim 1, Examiner errors in determining that Wendkos teaches means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery [0019]. Also, as discussed in the section 1.(a)(2) as to claim 1, Examiner errors in determining that Strandberg teaches a ... system..., comprising:... allocating uniquely an electronic mail address to each of participants [0018], [0019]. In addition, Sarno fails to disclose, teach or suggest these features. Moreover, the applied art fails to disclose, teach or suggest that “the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(b) Claim 9

Claim 9 depends on claim 6 which depends on claim 1, and as discussed in the section 1.(a)(1) as to claim 1, Examiner errors in determining that Wendkos teaches means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery [0019]. Also, as discussed in the section 1.(a)(2) as to claim 1, Examiner errors in determining that Strandberg teaches a ... system..., comprising:... allocating uniquely an electronic mail address to each of participants [0018], [0019]. In addition, Sarno fails to disclose, teach or suggest these features. Moreover, the applied art fails to disclose, teach or suggest that “by entering said access keyword and a destination electronic mail address to which the third electronic mail is sent, into the page informing of said result, the page for the win of the prize or the page of the failure in winning

the prize can be accessed.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

3. Claims 23-26 have been erroneously rejected under 35 U.S.C. § 103(a) as unpatentable over Strandberg in view of Wendkos and further in view of Libby et al.

(a) Claim 23

Claim 23 depends on claim 22 which depends on claim 21, and as discussed in the section 1.(g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest “means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers.” Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.” Moreover, the applied art fails to teach “said drawing is performed on the basis of the number of said participants of said main group.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(a) Claim 24

Claim 24 depends on claim 22 which depends on claim 21, and as discussed in the section 1.(g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest “means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers.” Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.” Moreover, the applied art fails to teach “said means for conducting the lottery generates random number on the basis of the number of said participants of said main group,

thereby obtaining the result of said lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(a) Claim 25

Claim 25 depends on claim 21, and as discussed in the section 1. (g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest “means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers.” Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.” Moreover, the applied art fails to teach “said lottery system further comprising means for recording a result of the lottery; wherein the result of said lottery is previously decided on the basis of the number of said participants of said main group before sending said electronic mail, and wherein said means for conducting the lottery includes means for confirming said unique access key with reference to said means for recording the result of the lottery when receiving said second electronic mail.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

(a) Claim 26

Claim 26 depends on claim 24 which depends on claim 21, and as discussed in the section 1. (g)(1) as to claim 21, Wendkos fails to disclose, teach or suggest “means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers.” Further, as discussed in the above section 1.(g)(2) as to claim 21, Examiner errors in determining that Strandberg teaches that “the interested party database 200 may contain such information concerning the interested part such as their name, address, telephone number, account history, and in the preferred embodiment of this invention an electronic mail (e-mail) address.” Moreover, the applied art fails to teach “said means for conducting the lottery

generates random number on the basis of the number of said participants of said main group, thereby deciding the result of the lottery.” Thus, Examiner fails to establish a *prima facie* case of obviousness. Accordingly, Appellant respectfully requests withdrawal of the rejection.

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Respectfully submitted,

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VIII. CLAIM APPENDIX

1. (PREVIOUSLY PRESENTED) A lottery system utilizing an electronic mail, comprising:
storing means for storing information of customers;
means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery;
means for uniquely allocating a reply electronic mail address to each of said specified participants, so that said reply electronic mail addresses are different from each other;
means for sending a first electronic mail to each of said participants, in which the reply electronic mail address is affixed as a unique access key to each of said participants;
means for recognizing an application for the lottery from each of said participants by receiving a second electronic mail sent back to said reply electronic mail address; and
means for notifying each one of said participants who sent back the second electronic mail to the reply electronic mail address of the result of said lottery.

2. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein the result of said lottery is obtained by a drawing performed when the participant applies for said lottery.

3. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein the result of said lottery is previously decided before said electronic mail is sent.

4. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein recognition of the participant for said lottery is performed based on said reply electronic mail address of each of said participants.

5. (CANCELED)

6. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein the notifying means notifies the result of said lottery to each of the participants, by sending a third electronic mail in which a URL of a page informing of the result and an access keyword, are affixed, to each of the participants.

7. (CANCELLED)

8. (PREVIOUSLY PRESENTED) The lottery system according to claim 6, wherein the URL of the page informing of said result is separated into one for a win of a prize and the other for a failure in winning the prize.

9. (PREVIOUSLY PRESENTED) The lottery system according to claim 6, wherein by entering said access keyword and a destination electronic mail address to which the third electronic mail is sent, into the page informing of said result, the page for the win of the prize or the page of the failure in winning the prize can be accessed.

10. (PREVIOUSLY PRESENTED) A lottery system utilizing an electronic mail, comprising:

storing means for storing information of customers;

means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery;

means for uniquely allocating a keyword to be entered in a page of a URL, to each of the participants so that the keywords are different from each other;

means for sending an electronic mail in which the keyword is affixed as a unique access key, to each of the participants;

means for recognizing an application from each of said participants when said participant accesses the page of said URL and enters the keyword; and

means for notifying each of said participants of the result of the lottery.

11. (PREVIOUSLY PRESENTED) The lottery system according to claim 10, wherein the keyword is a destination mail address of said electronic mail.

12. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein data of said participants who applied for the lottery is collected and stored.

13. (PREVIOUSLY PRESENTED) The lottery system according to claim 1, wherein said lottery system is entirely incorporated into a computer system.

14. (CANCELED)

15. (CANCELED)

16. (PREVIOUSLY PRESENTED) A method for conducting a lottery, comprising the steps of:

storing information of customers in a database;

limiting the customers stored in the database in advance so as to specify particular participants for a lottery;

allocating uniquely a reply electronic mail address to each of said specified participants so that the reply electronic mail addresses are different from each other;

sending by a host a first electronic mail in which the reply electronic mail address is affixed as a unique access key to each one of a plurality of said specified participants;

recognizing said specified participants for a lottery by receiving a second electronic mail sent back to said reply electronic mail address from each of said participants;

conducting said lottery; and

notifying each one of the participants who sent back the second electronic mail of their result of said lottery.

17. (CURRENTLY AMENDED) A lottery system utilizing an electronic mail, comprising:
storing means for storing information of customers;
means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery;
means for uniquely allocating a URL to each of said participants so that the URLs are different from each other;
means for sending an electronic mail in which the URL is affixed as a unique access key to each of the participants;
means for recognizing an application from each of the participants when the participant accesses a page of the URL and enters an electronic mail address of the participant; and
means for notifying each of said participants of the result of said lottery.

18. (PREVIOUSLY PRESENTED) The lottery system according to claim 10, herein the electronic mail contains the URL.

19. (PREVIOUSLY PRESENTED) A lottery system utilizing an electronic mail, comprising:

storing means for storing information of customers;
means for limiting the customers stored in the storing means in advance so as to specify particular participants for a lottery;
means for providing at least one electronic mail address;
means for allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other;

means for sending by a host a first electronic mail to each one of the specified participants, wherein the uniquely allocated at least one electronic mail address is affixed to the first electronic mail;

means for receiving a second electronic mail sent from each one of the specified participants to the uniquely allocated at least one electronic mail address, so as to recognize the participants;

means for conducting the lottery; and

means for notifying each one of the recognized participants who sent the second electronic mail, of a result of the lottery.

20. (PREVIOUSLY PRESENTED) A method for conducting a lottery, comprising the steps of:

storing information of customers in a database;

limiting the customers stored in the database in advance so as to specify particular participants for the lottery;

providing at least one electronic mail address;

allocating uniquely the at least one electronic mail address to each one of the specified participants so that the electronic mail addresses are different from each other;

sending by a host a first electronic mail to each one of the specified participants, wherein the uniquely allocated at least one electronic mail address is affixed to the first electronic mail;

receiving a second electronic mail sent from each one of the specified participants to the uniquely allocated at least one electronic mail address, so as to recognize the participants;

conducting the lottery; and

notifying each one of the recognized participants who sent the second electronic mail, of a result of the lottery.

21. (PREVIOUSLY PRESENTED) A lottery system utilizing an electronic mail comprising: recording means for recording information concerning customers, each of which has an electronic mail address;

means for limiting the customers in advance so as to specify a main group for performing a lottery, said main group being defined by at least one of the customers;

means for issuing a unique access key to be affixed to said electronic mail address of each of said participants of said main group;

means for assigning said unique access key to said electronic mail address to generate a reply electronic mail address for the lottery after specifying said main group for the lottery;

means for recording said unique access key in association with said electronic mail address of each of said participants of said main group;

means for sending by a host a first electronic mail to said reply electronic mail address of each of said participants of said main group, in which said unique access key is affixed to said reply electronic mail address of each of said participants of said main group;

means for recognizing an application for the lottery from each of said participants by receiving a second electronic mail sent back to said reply electronic mail address;

means for distinguishing said access key with reference to said means for recording said unique access key;

means for conducting the lottery; and

means for notifying each one of said participants who sent back said second electronic mail to said reply electronic mail address, of the result of said lottery.

22. (PREVIOUSLY PRESENTED) The lottery system according to claim 21, wherein a result of said lottery is obtained by a drawing performed when said participant applies for the lottery.

23. (PREVIOUSLY PRESENTED) The lottery system according to claim 22, wherein said drawing is performed on the basis of the number of said participants of said main group.

24. (PREVIOUSLY PRESENTED) The lottery system according to claim 22, wherein said means for conducting the lottery generates random number on the basis of the number of said participants of said main group, thereby obtaining the result of said lottery.

25. (PREVIOUSLY PRESENTED) The lottery system according to claim 21, wherein said lottery system further comprising means for recording a result of the lottery; wherein the result of said lottery is previously decided on the basis of the number of said participants of said main group before sending said electronic mail, and wherein said means for conducting the lottery includes means for confirming said unique access key with reference to said means for recording the result of the lottery when receiving said second electronic mail.

26. (PREVIOUSLY PRESENTED) The lottery system according to claim 25, wherein said means for conducting the lottery generates random number on the basis of the number of said participants of said main group, thereby deciding the result of the lottery.

IX. EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon by appellant in the appeal, thus there is no evidence attached hereto.

X. RELATED PROCEEDING APPENDIX

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Boards' decision in this appeal, and thus there are no copies of decisions rendered by a court or the Board in any proceeding to be attached hereto.